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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,949	02/12/2002	Thomas Huber	2050.072US1	3402
44367 7590 05/02/2008 SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				
EXAMINER SHANG, ANNAN Q				
ART UNIT 2623		PAPER NUMBER		
MAIL DATE 05/02/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/076,949

**Applicant(s)**

HUBER ET AL.

**Examiner**

ANNAN Q. SHANG

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/08/08 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the rejection of the last office action, Applicant amends claims and further argues that the prior arts of record do not teach the amended claim limitations (see page 12+ of Applicant's Remarks).

In response, Examiner notes Applicant's amendments/arguments, however the Examiner disagrees. Kitsukawa teaches all the claim limitations including checking by CPU-29, if a plurality of versions exist for the selected product and presenting the different versions to the user. Kitsukawa, further teaches using a user settings and preferences for processing of information and configuration of the system (col.5, line 56- col.6, line 18), but silent to comparing more than one version of the product with previously collected and stored preference information associated with the viewer.

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However, **Zigmond** discloses techniques for intelligent video ad insertion and further discloses comparing ads with previously collected and stored preference information associated with the viewer (figs.1, 4-8, col.4, line 53-col.5, line 14 and col.9, line 21-col.11, line 1+). Hence the amended claims do not overcome the prior arts of record. The amendment to the claims necessitated the new ground(s) of rejection discussed below. This office action is non-final.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-24 and 29-33, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitsukawa et al (6,282,713)** in view of **Zigmond et al (6,698,020)**.

As to claim 1, note the **Kitsukawa** reference figures 2 and 4-10, discloses method and apparatus for providing on-demand electronic advertising and further discloses a method of offering a product for sale presented on an interactive media system comprising:

A first database that contains customer identification and preference information (a server at TV Broadcast Station 'BS' of Head end 'HE'), where the BS/HE identifies a viewer and preference information of the viewer; a second database (Advertisement Server at BS/HE or Merchant site Server) and information describing the products

contained in at least one advertisement (col.1, line 35-col.2, line 15 and col.3, line 61-col.4, line 12);

Displaying an advertising message (CPU-29/Display 4A) on the interactive media system comprising at least one visual image of the product; and a first program for receiving a response from a viewer to the advertising message and a second program that presents information of the product to the viewer (figs.4-7, col.6, line 19-64);

Checking (CPU-29) if more than one version of the product contained within the product advertising message exists and if more than one version of the product exist then (figs.5-7); automatically selecting the item based on the user preference information; displaying information describing the item and displaying purchasing information that allows an easy purchase of the one version of the product (col.8, line 46-col.9, line 11 and col.11, line 62-col.12, line 32), note that following the selection of advertising mark 720, the CPU-29 checks and displays different versions and upon a further selections the CPU-29 again checks and displays different versions as shown in 706, i.e., when a car ads is selected the CPU-29 checks the various versions and displays car, car tires, type, car detailing services, car repair services, etc., (plurality of versions).

Kitsukawa, teaches using user settings and preferences for processing of information and configuration of the system (col.5, line 56-col.6, line 18), but silent to comparing more than one version of the product with previously collected and stored preference information associated with the viewer.

However, **Zigmond** discloses techniques for intelligent video ad insertion and further discloses comparing ads with previously collected and stored preference

information associated with the viewer (figs.1, 4-8, col.4, line 53-col.5, line 14 and col.9, line 21-col.11, line 1+).

Therefore it would have been obvious to one of ordinary skilled in the art at the time of the invention to incorporate the teaching of Zigmond into the system of Kitsukawa to compare a plurality of versions with previously collected and stored preference information associated with the viewer, to properly target specific ads based on viewer(s) preferences to generate income.

As to claims 2-3, Kitsukawa further discloses displaying purchasing icon, checking if billing and shipping information exist for the viewer and displaying a single purchase icon if the billing and shipping information exists and displaying the billing and shipping information (col.11, line 62-col.12, line 32), note that the user orders or purchases the product electronically and various transaction such as billing and shipping information is needed in order for the user to receive the desired product.

As to claims 4-5, Kitsukawa further discloses display image prior to broadcast of the image and combining the icon with a displayed image in the receiving unit (col.6, line 54-col.7, line 20, col.9, line 34-col.10, line 28 and line 45+).

As to claim 6, the claimed "A system for advertising and purchasing products presented on an interactive television system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 7 is met as previously discussed with respect to claims 2-3.

As to claim 8, the claimed "A method of offering a product for sale presented on an interactive television system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 9 is met as previously discussed with respect to claims 2-3.

As to claim 10, the claimed "A system for advertising and purchasing products presented on an interactive television system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 11 is met as previously discussed with respect to claims 2-3.

As to claim 12, the claimed "A method of advertising and selling products presented on an interactive television system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 13 is met as previously discussed with respect to claims 2-3.

As to claim 14, the claimed "A method of advertising and selling a product on an interactive media system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 15 is met as previously discussed with respect to claims 2-3.

As to claim 16, Kitsukawa further discloses changing the appearance of the object (figs.5-11, col.8, line 17-col.9, line 33, line 34-col.10, line 1+ and col.11, line 5+).

As to claim 17, Kitsukawa further discloses displaying an icon in conjunction with the object (col.8, line 17-col.9, line 33, line 34-col.10, line 1+ and col.11, line 5+).

As to claims 18-19, Kitsukawa further discloses displaying text over the object and displaying a graphic image over the object (col.8, line 17-col.9, line 33, line 34-col.10, line 1+ and col.11, line 5+).

As to claims 20-21, Kitsukawa further discloses warping the text to conform to the shape of the object and warping the graphic image to conform to the shape of the object (col.8, line 17-col.9, line 33, line 34-col.10, line 1+ and col.11, line 5+).

As to claim 22, the claimed "A system for advertising and purchasing a product presented on an interactive media system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claims 23-24 are met as previously discussed with respect to claims 2-3.

As to claim 29, the claimed "A system for advertising and selling a product presented on an interactive television system..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 30 is met as previously discussed with respect to claims 2-3.

As to claim 32, the claimed "A method of offering a product for sale in conjunction with motion video program presented on an interactive media..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 33 is met as previously discussed with respect to claims 2-3.

5. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitsukawa et al (6,282,713)** in view of **Zigmond et al (6,698,020)** as applied to claim 22 above and further in view of **Matsko (2002/0062254)**



As to claims 25-28, Kitsukawa as modified by Zigmond, fail to explicitly teach information of past purchases by the customer, determining a price for the product employing loyalty information, history of past purchases of products from the same retailer/manufacturer.

However, note the **Matsko** reference discloses determining customer purchasing history and determining a price for the product employing loyalty information, history of past purchases of products from the same retailer/manufacturer (fig.1, page 2, [0018-0019]).

Therefore it would have been obvious to one of ordinary skilled in the art at the time of the invention to incorporate the teaching of Matsko into the system of Kitsukawa as modified by Wolff to provide special incentives to specific customers or members or frequent shoppers.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on 700am-400pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, **call 800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Annan Q Shang/  
Primary Examiner, Art Unit 2623

**Annan Q. Shang**